

## REMARKS

### A. Background

Claims 7-15, 17, 19, 21-26, 29, and 43-46 were pending in the application. The Office Action of March 5, 2002 rejected claims 7-15, 17, 19, 21-26, 29, and 43-46 (all of the claims) under 35 U.S.C. §103(a) as being obvious over cited prior art. By this paper, applicants have amended claims 7, 8, 11, 12, 15, 19, 29, 43, and 46. As such, claims 7-15, 17, 19, 21-26, 29, and 43-46 are presented for Examiner's consideration on the merits.

### B. Proposed Amendments

Support for the amended claims is found at page 7, line 36 through page 9, line 30. More specifically, support for "user-selected field types" is found at page 7, line 36 through page 8, line 26 and support for "user-selected behaviors" is found at page 8, line 27 through page 9, line 30.

Attached hereto is a marked-up version of the changes made to the previous version of the claims by this amendment. The attached pages are captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

### C. Rejections on the Merits

The Office Action rejected claims 7, 9-11, 29, and 44-46 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,119,472 to Texier in view of Dayton, Doug *PerForm Pro Expands simple WYSIWYG form Design, Filling*, PC Week, Vol. 7, No. 39, October 1, 1990, pp. 33-35 (hereinafter referred to as the "Dayton article"). As a preliminary matter, Applicants do not necessarily concede the accuracy of the Office Action's assertions with respect to the

teachings of Texier or the Dayton article. This response, therefore, should not be deemed as acquiescing that Texier or the Dayton article necessarily teach what the Office Action asserts. Further, Applicants do not necessarily concede the prior art status of the Dayton article. This response, therefore, should not be deemed as acquiescing that the Dayton article necessarily qualifies as prior art.

Texier teaches a method for creating data entry forms to be displayed on a computer display. (Col. 1, lines 61-66). The forms include at least one “active” zone that reacts with an external event such as operator initiated input. (Col. 2, lines 5-7). At least one reaction function is associated with the active zone, the reactive function being performed in response to the external event. (Col. 2, lines 8-14). As recognized in the Office Action at page 3, paragraph 4, “Texier does not specifically teach providing a plurality of defined field types and defined behaviors presented for user selection.” This represents a significant lack of teaching in Texier as applied to the claims.

Applicants submit that since Texier does not specifically teach providing a plurality of defined field types presented for user selection, there exists no motivation or suggestion to modify Texier to create a custom field having a selected field type from among a plurality of defined field types. More specifically, there is no suggestion or motivation to modify Texier for “creating a custom field in the custom form, the custom field having the user-selected field type . . .” when the user-selected field type is “a user-selected field type from among the plurality of defined field types,” as recited in claim 7 (emphasis added). Applicants further submit that since Texier does not specifically teach providing a plurality of defined behaviors presented for user selection, there exists no motivation or suggestion to modify Texier to create a custom field having a selected behavior or perform a selected behavior from among a plurality of defined

behaviors. More specifically, there is no suggestion or motivation to modify Texier for “creating a custom field in the custom form, the custom field having . . . the user-selected behavior” or for “performing the user-selected behavior for the custom field” when the user-selected behavior is “a user-selected behavior from among the plurality of defined behaviors,” as recited in claim 7 (emphasis added).

The Dayton article describes and reviews form creation software called PerForm Pro. Applicants note that even if the Dayton article is assumed to be prior art, the Dayton article teaches that PerForm Pro can be used to create, modify, or place information in different “objects” to design a form. (Page 34, paragraph 2). During the design of a form, objects can be manipulated using a “Designer’s toolbox” that includes tools with modifiable features. (Page 34, paragraph 3). After a form is designed, “‘tab groups’ can be programmed to jump to data-entry fields, depending on the data entered.” (Page 34, paragraph 4).

In order to understand the significant differences between the Dayton article and the claimed invention, it is critical to distinguish between functions, tools, and toolboxes generally (even those that are related to particular fields in form), and “performing [a] user-selected behavior . . .” that is “in response to receiving data input into the custom field,” as recited in claim 7. Applicants note that the majority of the functions or tools mentioned in the Dayton article, including the toolbox and tools recited in the Office Action at page 3, paragraph 4, are used only to design a form. That is, “forms are constructed by selecting and assembling text and graphics objects.” (Page 34, paragraph 2) (emphasis added). Further, “creating text and graphics fields and drawing lines and shapes are accomplished with Designer’s toolbox.” (Page 34, paragraph 3) (emphasis added). However, with respect to the toolbox and tools, the Dayton article does not mention “providing a plurality of defined behaviors that can be associated with

data input into the custom fields that can be included in custom form,” as recited in claim 7 (emphasis added). For example, with respect to the toolbox and the tools, the Dayton article does not teach or suggest any customized behavior that is implemented “in response to receiving the data input into the custom field” as required by claim 7.

The Dayton article very briefly mentions that “PerForm Filler” can be “used for managing, filling, and printing forms.” (Page 33, paragraph 5). However, there is no technical description on how managing, filling, or printing functions are implemented, and thus there is no reason to believe (and there is thus no teaching by the Dayton article) that managing, filling, or printing functions are custom behaviors that are implemented in response to data input into the custom field.

Likewise, the Dayton article very briefly mentions that “linked forms serve as a database front end and provide file lookup and field checking . . .” (Page 33, paragraph 6). One again, due to the very brief length of the Dayton article, there is characteristically no technical description on how file lookup and field checking is performed. Accordingly, once again, there is no reason to believe (and there is thus no teaching by the Dayton article) that such file lookup and field check has anything resembling a custom behavior that is implemented in response to data input into a custom field.

The Dayton article specifically mentions only one function of PerForm Pro that can be used after a form is designed. We note that data being input into a form is performed after a form is designed. Specifically, the Dayton article mentions, “once the text and graphic fields are created, ‘tab groups’ can be programmed to jump to data-entry fields, depending on the data entered.” (Page 34, paragraph 4). It is unclear, from this very brief description in the Dayton article, whether this jumping operation is “user-selectable” and how the tab group is programmed

generally. In addition, it is unclear whether the Dayton article teaches a custom field that is created with tab groups, or whether the tab groups is created after the creation of the data-entry field. In the latter case, the data entry fields would not be “custom fields [that have] . . . the user-selected field type and the user-selected behavior,” as recited in claim 7 (emphasis added).

Generally, the Dayton article provides abstract and ambiguous mention of the functionality of PerForm Pro with little, if any, technical description of how functionality is implemented. Applicants submit that the Dayton article does not in fact teach anything, as one of ordinary skill in the art at the time the invention was made, could not implement any of the functionality mentioned in the Dayton article. Applicants further submit that the Dayton article is not an enabling reference. A reference that lacks enabling disclosure “may qualify as a prior art *reference* under § 103, but only for what is disclosed in it.” *Reading & Bates Constr. Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 652, 223 USPQ 1168, 1173 (Fed. Cir. 1985) (emphasis in original). . .

Thus, neither Texier nor the Dayton article teach or suggest “providing a plurality of defined behaviors that can be associated with data input into the custom fields that can be included in a custom form,” as recited in claim 7 (emphasis added). For at least this reason, applicants submit that claim 7 is neither anticipated nor obvious over the prior art.

Claims 9-11 depend from claim 7 and thus incorporate the limitations thereof. As such, applicants submit that claims 9-11 are distinguished over the prior art for at least the same reasons as discussed above with regard to claim 7.

Claim 29 is a computer-program product claim that corresponds to the method of claim 7. Applicants submit that claim 29 are distinguished over the prior art for at least the same reasons as discussed above with regard to claim 7.

Claims 43-46 depend from claim 29 and thus incorporate the limitations thereof. As such, applicants submit that claims 43-46 are distinguished over the prior art for at least the same reasons as discussed above with regard to claim 29.

Claims 8, 12-15, 17, 19, 21-26, and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over Texier in view of the Dayton article and in further view of U.S. Patent No. 5,404,294 to Karnik. Applicants do not necessarily concede the prior art status of Karnik or the accuracy of the Office Action's assertions with respect to the teachings of Karnik. This response, therefore, should not be deemed as acquiescing that Karnik necessarily qualifies as prior art or as acquiescing that Karnik teaches what the Office Action asserts.

Applicants note that even if Karnik is assumed to be prior art, Karnik describes the movement of data between databases and pre-printed forms. Karnik teaches that a tag (field) "can be linked" to other tags (fields) arithmetically to perform formulas (Col. 6, lines 8-17). However, Karnik gives no indication of how this linking occurs. Thus, Karnik does not teach or suggest displaying a form with custom fields where each custom field has "a user-selected custom behavior associated with data input into the field, the user-selected custom behavior being selected by the user from among a plurality of defined custom behaviors that are supported by the computer system," as recited in claim 12 (emphasis added). For at least this reason, applicants submit that claim 12 is neither anticipated nor obvious over the prior art. Applicants further submit that claim 12 also distinguishes over the prior art for at least the same reasons as claim 7.

Claims 13-15 and 17 depend from claim 12 and thus incorporate the limitations thereof. As such, applicants submit that claims 13-15 and 17 are distinguished over the prior art for at least the same reasons as discussed above with regard to claim 12.

Applicants submit that claim 19 is also distinguished over the prior art for substantially the same reasons as discussed with regard to claim 12. Specifically, application submits that none of the references individually or in combination teach or suggest “a user-selected custom behavior associated with data input into the custom field, the user-selected custom behavior being selected by the user from among a plurality of defined custom behaviors that are supported by the computer system,” as recited in claim 19 (emphasis added). Applicants further submit that claim 19 also distinguishes over the prior art for at least the same reasons as claim 7.

Claims 21-26 depend from claim 19 and thus incorporate the limitations thereof. As such, applicants submit that claims 21-26 are distinguished over the prior art for at least the same reasons as discussed above with regard to claim 19.

Claim 8 depends from claim 7 and thus incorporates the limitations thereof. As such, applicants submit that claim 8 is distinguished over the prior art for at least the same reasons as discussed above with regard to claim 7. Applicants further submit that claim 8 is independently distinguished over the prior art because Karnik does not teach or suggest that a “user-selected behavior modifies the display of a field other than the custom field,” as recited in claim 8 (emphasis added).

#### D. Conclusion

For the foregoing reasons, Applicants submit that the pending claims are in condition for allowance and courteously request favorable action. If there are any outstanding issues that could be resolved by telephone, the Examiner is invited to contact the undersigned attorney.

Dated this 5<sup>th</sup> day of August, 2002.

Respectfully submitted,



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**VERSION WITH MARKINGS TO SHOW CHANGES MADE  
IN THE CLAIMS**

Claims 7, 8, 11, 12, 15, 19, 29, 43, and 46 have been amended as follows:

7. (Twice amended) A method in a computer system for processing data using a custom form having a field that has been customized by a user of the computer system, the method comprising:

    providing a plurality of defined field types that can be associated with custom fields that can be included in the custom form;

    providing a plurality of defined behaviors that can be associated with data input into the custom fields that can be included in the custom form;

    receiving user input selecting:

        a user-selected field type from among the plurality of defined field types;  
        and

        a user-selected behavior from among the plurality of defined behaviors;  
        creating a custom field in the custom form, the custom field having the user-selected field type and the user-selected behavior;

    displaying the custom form, including the custom field, on a display device;

    receiving data directed input into the custom field of the displayed custom form;  
    and

    in response to receiving the data directed input into the custom field, a -form control procedure of the computer system performing the user-selected -behavior for the custom field.

8. (Twice amended) The method of claim 7 wherein the user-selected -behavior modifies the display of a field other than the custom field.

11. (Twice amended) The method of claim 7 including, under control of the -form control procedure, returning an indication whether to perform the user-selected behavior for the custom field, wherein -performing the user-selected -behavior for the custom field is conducted when the returned indication specifies that the user-selected behavior is to be performed.

12. (Twice amended) A method in a computer system for processing data using a custom form having a field that has been customized by a user of the computer system, the method comprising:

displaying the custom form, the custom form having one or more custom fields, wherein each custom field has:

a user-selected custom field type that has been selected by a user from among a plurality of defined custom field types that are supported by the computer system; and

a user-selected custom behavior associated with data input into the field, that has been the user-selected custom behavior being selected by the user from among a plurality of defined custom behaviors that are supported by the computer system;

receiving data directed input into a particular field of the custom form; in response to receiving the data, performing the acts of:

determining that the particular field is a custom field that has a user-selected custom behavior; and

in response to the act of determining, performing the user-selected custom behavior for the particular field; and

determining whether to perform another behavior for the particular field in response to the user-selected custom behavior having been performed.

15. (Twice amended) The method of claim 12, further comprising, prior to the act of performing the user-selected custom behavior, the act of determining whether the user-selected custom behavior is to be performed prior to performing said other behavior.

19. (Twice amended) A method in a computer system for processing data using a form having a custom field that has been customized by a user of the computer system and for applying a custom behavior and a standard behavior to the custom field, the method comprising:

displaying the custom form, the custom form having a custom field, wherein the custom field has:

a user-selected custom field type that has been selected by a user from among a plurality of defined custom field types that are supported by the computer system;

a user-selected custom behavior associated with data input into the custom field, that has been the user-selected custom behavior being selected by the user from among a plurality of defined custom behaviors that are supported by the computer system; and

a standard behavior, wherein the standard behavior is a behavior that is supported by the computer system and applied to the data field without the user being required to select the standard behavior;

receiving data directed input into the custom field;

invoking a form control procedure operating at the computer system;

passing information identifying the custom field to the form control procedure;

receiving an indication from the form control procedure to perform the standard behavior for the field;

performing the standard behavior for the custom field;

re-invoking the form control procedure; and

using the form control procedure, performing the user-selected custom behavior for the custom field.

29. (Twice amended) A computer-readable medium containing instructions for causing a computer system to perform a method for processing data using a custom form having a field that has been customized by a user of the computer system, the computer-readable medium comprising:

computer-executable instructions carried by the computer-readable medium, the computer-executable instructions, when executed by the computer system, causing the computer system to perform the method, including the acts of:

providing a plurality of defined field types that can be associated with custom fields that can be included in the custom form;

providing a plurality of defined behaviors that can be associated with data input into the custom fields that can be included in the custom form; receiving user input selecting:  
a user-selected field type from among the plurality of defined field types; and  
a user-selected behavior from among the plurality of defined behaviors; creating a custom field in the custom form, the custom field having the user-selected field type and the user-selected behavior; displaying the custom form, including the custom field, on a display device; receiving data directed input into the custom field of the displayed custom form; and in response to receiving the data directed input into the custom field, a form control procedure of the computer system performing the user-selected behavior for the custom field.

43. (Amended) The computer-readable medium of claim 29, wherein the user-selected behavior modifies the display of a field other than the custom field.

46. (Amended) The computer-readable medium of claim 29, including, under control of the form control procedure, returning an indication whether to perform the user-selected behavior for the custom field, wherein performing the user-selected behavior for the

custom field is conducted when the returned indication specifies that the user-selected behavior is to be performed.